

ESTTA Tracking number: **ESTTA593822**

Filing date: **03/20/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91205076
Party	Plaintiff Mr. Winston A. Rosa
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Date	03/20/2014
Attachments	FINAL REBUTTAL FULANITO.pdf(128547 bytes ) Conclusion USPTO.pdf(526451 bytes ) Breif Rebuttal Cerified.pdf(69678 bytes ) Receipt USPTO.pdf(310401 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

-----X  
WINSTON ROSA,

Plaintiff,

<against>

Opposition No. 91205706  
Application No: 85480930  
Mark: FULANITO  
Filed: Nov. 25, 2011  
Published: May 8, 2012

RAFAEL ROBERT VARGAS,

Defendant

-----X

PLAINTIFF’S REPLY BRIEF

I, Winston Rosa (“Opposer” or “Plaintiff”) timely submit this reply to Defendant’s (“Applicant” or “Vargas”) Trail Brief, filed in accordance with Trademark Rules 2.128 (a) and (b), 37 C.F.R. §§ 2.128 (a) and (b).

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## I. INTRODUCTION

This case has been brought fourth to the TTAB in hopes that my family and I will finally receive the justice we have been waiting for since the plaintiff first decided to leave the band all the while trying to take the trademark that (a) did not belong to him alone and (b) which he is now trying to register it in the USPTO for his own benefits. Totally disregarding the work and efforts others have put fourth to make the band successful. I've claimed time and again that he and I are 50 % partners of the trademark because that was the agreement between us and since we were all from the same family (Defendant was my Brother-in-Law for nearly 18 years), there was never any threat until recent times to have any legal actions taken to protect the name of our band until this case came to be. Also if the mark was truly the property of the defendant, why did he wait so long to register

the mark in question? As you will find in the evidence and testimonies and even by the defendant's own admission on Document - 26 page 11 where he states "an examination of the Exhibits and records show clearly that both parties have been and are using the Mark in commerce.

There is no dispute that the Mark was being used in commerce by both Applicant and Opposer."

This being true than;

Moreover, it is settled law that a trademark such as Kingsmen need not be registered.

National Lampoon, Inc. v. American Broadcasting Cos., 376 F.Supp. 733, 747 (S.D.N.Y.),aff'd, 497 F.2d 1343 (2d Cir.1974); Rare Earth, Inc. v. Hoorelbeke, 401 F.Supp. at 37 n. 19.

"Usage, not registration, confers the right to a trademark." WGBH Educational Foundation, Inc. v. Penthouse International Ltd., 453 F.Supp. 1347, 1350 (S.D.N.Y.1978), aff'd mem., 598 F.2d 610 (2d Cir.1979). Clearly by these statements alone, I have met the burden of proof the applicant is not entitled to register the mark alone on the grounds that it's registration will cause likelihood of confusion and if he is allowed to perform alone as FULANITO, the public will be deceived in that they will pay to see FULANITO the band and will instead see a one man show.

## **II. In Response to EVIDENTIARY DISPUTES**

### **A. DEPOSITION OF SAMUEL SERRATY**

In response to Defendant's request to have Samuel Serraty's testimony stricken from the record, I ask the court to disregard the Defendant's request based on these findings:

1. That the Defendant's attorney claims that "As a result of technical issues, council for the Applicant was unaware of this deposition at the time"and claiming that "the entire file did not download and counsel was unaware that this testimony was on record" are not sufficient enough

cause for the TTAB to strike it or the evidence attached from the records.

3. Also witness # 11. Ney Pimentel of said Witness List, was not available for questioning and since Mr. Serraty worked together with Mr. Pimentel on our website FULANITO.com, a legitimate connection was established between the two witnesses. Because of Mr. Serraty's knowledge of the website (FULANITO.com) he was called upon to testify. His testimony clearly has great importance to this case. This witness being able to present his testimony in the deposition brought fourth to the TTAB will help the TTAB tremendously in it 's decision on this case.

## **B. EXHIBITS A-L PURPORTEDLY SERVERED ON MAY 8, 2012**

### *i. Failure to Provide Proof Of Service.*

In response to the claim "Email is not an accepted form of service unless consented to in writing by and between both parties", the defendant did not answer any of his correspondence nor did he reply to emails sent by both the TTAB and myself. So a consent by Defendant could not be obtained due to the Defendant's lack of involvement in said case. Therefore Exhibits A-L should be allowed on the trail records and be considered by the Board when deciding on this case.

### *ii. Failure to File Notice Of Reliance*

In reply to the claim by Defendant Failure to File Notice of Reliance, this is also due in part by applicant's neglect. He refused for whatever reason to not answer any of my emails also the TTAB has already once denied request to re-open discovery stating from DOCUMENT # 24 page 8 (DEFENDANT's MOTION TO RE-OPEN DISCOVERY - DENIED) that:

"In view thereof, the Board finds that the delay to the proceeding caused by applicant's delay in acting during his discovery and testimony periods is significant. Thus, this factor also weighs against applicant." and "Similarly, applicant was unsure as to whether he was allowed to request discovery

from opposer, and “ultimately did not understand the rules of procedure utilized by the TTAB and which governed this dispute” (Id., ¶13; see also declaration of Rafael Robert Vargas, ¶17). It is well-established that misunderstanding of the rules applicable to Board proceedings does not constitute excusable neglect. Moreover, applicant has failed to provide any rationale as to why applicant’s newly-appointed counsel did not file a motion to extend applicant’s testimony period prior to the close of that period. Clearly, the decision to wait to file any motion before the Board was in the reasonable control of applicant. In view of the foregoing, the Board finds that the third Pioneer factor weighs heavily against applicant.

Also from Document # 24 Page 8 :

The conduct of opposer’s testimony deposition on July 9, 2013, that is, during his testimony period was timely. See Trademark Rules 2.121 and 2.123. Likewise, opposer’s submission of the testimony transcript on July 31, 2013, was timely.<sup>3</sup> See Trademark Rules 2.125 and 2.196. In view of the foregoing, applicant’s motion to strike opposer’s testimony deposition on the grounds of untimeliness is denied.

### **III. STATEMENT OF ISSUES**

Whether applicant can prove he has more right to the name than the plaintiff through (a) ownership of a registration; (b) through prior use of an unregistered Mark or a trade name; (c) or earlier use analogous to a trademark?

#### **IV. FACTS**

In 1991 Applicant/Defendant was in a band called "2 In A Room" that sang and composed English only lyrics before meeting up and forming an equal partnership production company called Windose International in or around 1994 with the plaintiff Winston Rosa and his family who come from a lineage of composers/singers/musicians who performed Spanish songs from Latin America for many generations. In or around 1997 my father Jose Caba recorded a song with us and suggested we call the band "FULANITO". The band songs and even the word itself "FULANITO" are all in Spanish. Defendant never composed/recorded or performed in Spanish context until he met the plaintiff and his family. Defendant did not even understand what "FULANITO" meant until plaintiff's father Jose Caba (my father) explained it to him. For years both Defendant and I were equal owners/partners of the band. As equal partners we would share all cost and responsibilities assumed by the band as the evidence suggest. As for my relationship with my father Jose Rosa Caba, we and I act as one, always in the best interest of the family and our band members, this is to say his word is as good as mine. Since my father speaks no English I represent him and the family's interest and have been using the Mark since inception and remain the lawful owner.

#### **V. ARGUMENT**

#### **The Applicant Has Failed To Show He Is The 100 % Owner Of The Mark**

If the defendant truly believes that the mark is his alone as his Application suggest, why did he decide to write me a friendly message via Facebook saying " he would never deny my involvement

since it's (the mark's) inception (see Document # 17 Exhibit I) . Why not simply just state the claim that the mark was his and no one else's in the very same message? That is because neither him nor I created the word "Fulanito" but in fact it was first suggested by my father that the band be called that. The point is either way it was not the defendant who first came up with this concept and is now trying to apply for it alone as an "individual solo artist" as stated on his trademark application.

**These Excerpts Were Taken from Similiar Cases ;**

As Judge Herlands aptly recognized in Geisel v. Poynter Products, Inc., supra, 283 F.Supp. at 267, the essence of a § 43(a) claim is the misuse of a "distinguishing characteristic" of a manufacturer's product or of the manufacturer himself causing confusion to the buying public as to the origin of the product, which may arise from "a `false representation', whether express or implied, that a product was authorized or approved by a particular person. Accepting the application submitted by Defendant will cause Applicant to not share the trademark with the rest of the original members, instead he will seek to destroy all websites and social accounts related to the band that where legally obtained and would deny use of a Mark to all of us.

In 1986, the District of Massachusetts decided the case of Bell v. Streetwise Records. The case dealt with the plaintiffs continue to receive royalties and that preliminary injunctive relief is therefore appropriate. The band New Edition. After being discovered and mentored by a producer in the music industry, New Edition was able to become a commercial success. After releasing a few albums, the band decided to switch labels. The dispute reached the district court because both the original record company and the band wanted to use the name New Edition. In deciding the case, the court had to determine what exactly a band sells. The court discussed whether albums or concert performances were the primary good or service identified with the name New Edition.



A determination of the album would have favored the record industry because music producers are more involved with record production compared to live performance. The court decided to combine the two and identified New Edition relating to the overall entertainment services the band provided. In determining who controlled the nature of the entertainment services, the Court looked at the band's history. Before being discovered, the band members could not read or write music. The music producer played five instruments at a time during the bands early performances. (I'm not entirely sure the judge completely believed this claim, but he did put it in his opinion.) The court ultimately found that it did not matter how much help the band needed to get off the ground because the band members are ultimately, what consumers think of when they hear the term New Edition. The court awarded the band the use of the name. Although neither side concedes any of these prerequisites, the primary focus was on the first — the likelihood of success on the merits. In order to prevail on the merits, plaintiffs or defendants must establish that the mark is valid and protectable, that they own the mark, and that use of the mark by the opposing party is likely to confuse the public. See, e.g., *Estate of Presley v. Russen*, 513 F.Supp. 1339, 1362 (D.N.J.1981). Both sides concede that New Edition is a distinctive mark, protectable under state and federal law; it is accordingly unnecessary to pass on that issue. They also concede, and the opinion of the Court of Appeals assumes, that use of the mark by both plaintiffs and defendants will lead to public confusion. Thus this court must decide the sole remaining issue: who owns the mark. With these principles in mind, I make the following findings of fact. First, on the basis of testimony by Mr. Busby and by defendants' expert, Thomas Silverman, I find that there is only one relevant market at issue here: the entertainment market. Second, I find that as of the release of "Candy Girl" in February 1983—the first use in commerce — plaintiffs,

calling themselves New Edition, had publicly performed in the local entertainment market on at least twenty occasions. Those performances (for which they frequently received compensation; albeit in nominal amounts), the promotional efforts by Travis Gresham on their behalf, their regular rehearsals with Gresham and Payne, their attempt to win a recording contract, and their hard work with Maurice Starr to further their career, all evidence a "present plan of commercial exploitation." I accordingly conclude that plaintiffs have acquired legal rights to the mark New Edition through their prior use in intrastate commerce. Even if defendants' use had been the first in interstate commerce, they used the name simultaneously in Massachusetts, where plaintiffs had already appropriated it. And while it is well recognized that a junior user may occasionally acquire superior rights to a mark it used in good faith and in a different market, see 2 J. McCarthy, Trademarks and Unfair Competition, § 26:3 at 289-292 (2d ed. 1984), and cases cited therein, that was obviously not the case here. On this basis alone, plaintiffs own the mark. It is settled law that ownership of a mark is established by priority of appropriation. 580\*580 Blanchard Importing & Distributing Co. v. Charles Gelman, 353 F.2d 400, 401 (1st Cir.1965), cert. denied, 383 U.S. 968, 86 S.Ct. 1273, 16 L.Ed.2d 308 (1966). Priority is established not by conception but by bona fide usage. The claimant "must demonstrate that his use of the mark has been deliberate and continuous, not sporadic, casual or transitory." La Societe Anonyme des Parfums LeGalion v. Jean Patou, Inc., 495 F.2d 1265, 1272 (2d Cir.1974) (citing 3 Callmann, Unfair Competition, Trademarks & Monopolies § 76.2(d) (1969).

While it is not required that a product be an instant success the moment it hits the market, its usage must be consistent with a "present plan of commercial exploitation." Id. at 1273. Finally,

while the Lanham Act is invoked only through use in interstate commerce, common law rights can be acquired through interstate or intrastate usage. *Noah's Inc. v. Nark, Inc.*, 560 F.Supp. 1253, 1258 (E.D.Mo.1983), *aff'd*, 728 F.2d 410 (8th Cir.1984) (citing *Weiner King, Inc. v. Weiner King Corp.*, 201 U.S.P.Q. 894, 908 (TTAB 1979)). Based on the totality of the evidence, I conclude that the quality which the mark New Edition identified was first and foremost the five plaintiffs with their distinctive personalities and style as performers. The "goods" therefore are the entertainment services they provide. They and no one else controlled the quality of those services. They own the mark.

Also in *Kingsmen v. K-Tel Intern. Ltd.*, 557 F. Supp. 178 SD New York ; Although the listener can discern the lead singer from the background vocals and music on a number of Kingsmen songs, the group's "sound" is clearly a collective one. No one member of the group can be singled out as representing the essence of The Kingsmen's performing style. Given the evidence referred to above and the nature of The Kingsmen's recordings to which we have listened, we find as a fact for purposes of this preliminary proceeding that the five plaintiffs herein constitute the band known to the public as The Kingsmen and therefore have standing to sue under the Lanham Act. It may very well be that given the collective sound of The Kingsmen, no single member of the group would be able to hold himself out as The Kingsmen without a substantial likelihood of confusion on the part of the public. Finally, there is little doubt that this confusion will cause financial harm to the plaintiffs. The plaintiffs continue to receive royalties from the sale of albums containing Louie, Louie. Every time a consumer purchases one of defendants' records, thinking he is getting a recording of Louie, Louie by The Kingsmen, the royalties owed the plaintiffs are reduced.

In the development of § 43(a) case law, the decision of the Third Circuit in *L'Aiglon Apparel, Inc. v. Lana Lobell, Inc.*, 214 F.2d 649 (3 Cir. 1954), stands as a benchmark. Judge Hastie, speaking for the court, there concluded that by virtue of § 43(a) "Congress has defined a statutory civil wrong of false representation of goods [and services] in commerce and has given a broad class of suitors injured or likely to be injured by such wrong the right to relief in the federal courts." *Id.* at 651. That Hoorelbeke and Urso have alleged facts sufficient to bring them within the ambit of this sui generis statutory tort is clearly manifested by reference to their pleadings. In summary, the contentions posited by the defendants are as follows: (1) that in July, 1974, the third-party defendants unlawfully usurped control of Rare Earth, Inc. and, thereupon illegally discharged Hoorelbeke and Urso; (2) that, thereafter, the third-party defendants arrogated to themselves the right to perform under the "RARE EARTH" name; (3) that since July 1974 these individuals have falsely identified themselves as the "RARE EARTH" performing group and have improperly claimed the right to use the corporate name and mark in connection with their musical entertainment services; (4) that the third-party defendants have used and intend to continue to use the "RARE EARTH" name and mark as a false description and false representation for themselves and for others acting in concert with them as a musical performing group; (5) that this conduct has caused or is likely to cause confusion of or mistake by the public and result in damage to the goodwill belonging to Rare Earth, Inc. and to the defendants in the "RARE EARTH" mark and name; (6) that the third-party defendants have acted and are acting to palm off their services as rendered, authorized, sponsored or endorsed by Rare Earth, Inc.; (7) that the conduct of the third-party defendants has been in or affecting interstate commerce; and (8) that Hoorelbeke and Urso are being and are likely to be damaged as the result of these activities. (Answer ¶¶ 7-19;

Third-Party Complaint ¶¶ 7-19.) These pleaded assertions, together with the established fact that the Bridges-Guzman faction has, since July 12, 1974, performed and held itself out in interstate commerce as the Rare Earth performing group, when joined with the stipulated fact that Rare Earth, Inc. is the owner of the "RARE EARTH" name and 37\*37mark, clearly satisfy the statutory requisites.

## **VI. CONCLUSION**

Based on these findings it is clear that I too have just as much rights as Rafael Robert Vargas in using the Trademark so therefore the Application to the Defendant should be denied.

Submitted and Dated by,

A handwritten signature in black ink, appearing to read 'W. Rosa', is written over a horizontal line.

Thursday, March 20, 2014

Winston A. Rosa

Third-Party Complaint ¶¶ 7-19.) These pleaded assertions, together with the established fact that the Bridges-Guzman faction has, since July 12, 1974, performed and held itself out in interstate commerce as the Rare Earth performing group, when joined with the stipulated fact that Rare Earth, Inc. is the owner of the "RARE EARTH" name and 37\*37mark, clearly satisfy the statutory requisites.

## VI. CONCLUSION

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Submitted and Dated by,



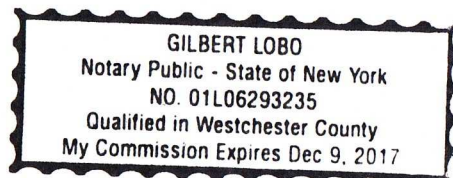
Thursday, March 20, 2014

Winston A. Rosa

Subscribed and sworn before me this  
20<sup>th</sup> day of March 2014.



Gilbert Lobo



Thursday, March 20, 2014

**MR WINSTON A ROSA**  
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**Proof Of Service**

I hereby certify that a true and complete copy of the foregoing Final Brief Rebuttal for Opposition # 91205076, has been served by mailing on Thursday, March 20, 2014 through U.S. Postal Service Certified mail to (Please see attached copy of receipt):

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Respectfully,

A handwritten signature in black ink, appearing to read 'Winston A. Rosa', written over a horizontal line.

Thursday, March 20, 2014

**MR. WINSTON A ROSA**



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Expected Delivery: Sat 03/22/14  
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Issue PVI: =====  
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Total: =====  
\$5.60

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VISA \$5.60

Account #:	XXXXXXXXXXXX8680
Approval #:	000819
Transaction #:	620
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